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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,363	09/29/2000	Philippe Vivarelli	99RSS340	4672
20594	7590	09/20/2005	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD, LLP			PARK, CHAN S	
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DALLAS, TX 75313-0688			PAPER NUMBER	
			2622	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/678,363	<b>Applicant(s)</b> VIVARELLI, PHILIPPE	
	<b>Examiner</b> CHAN S. PARK	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 7/5/05, and has been entered and made of record. Currently, **claims 1-12 and 14-21** are pending.

### *Specification*

2. The corrected or substitute specification was received on 7/5/05. The specification is acceptable.

### *Response to Arguments*

3. Applicant's arguments, see pages 7-9, filed 7/5/05, with respect to 35 U.S.C. § 112 Rejection have been fully considered and are persuasive. The rejection of claim 9 has been withdrawn. As the applicant states, examiner construes a "fax gateway" as an Internet Service Provider that provides for Fax Over IP Protocol and T38 Protocol (last section of page 8).

4. Applicant's arguments, see pages 8-11, filed 7/5/05, with respect to 35 U.S.C. § 102(a) and 35 U.S.C. § 103(a) Rejections have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kulakowski (WO 97/10668).

5. Examiner previously requested the applicant to provide a reference(s) that teaches the features disclosed in the Background of the Specification upon filing a

response to the previous Office action (paragraph 3 of last Office action). No reply to this request has been received in the current amendment. Again, the applicant is requested to provide the reference(s) in order to better take a decision on patentability.

### ***Claim Objections***

6. Claim 16 is objected to because of the following informalities:

Line 4, "IP protocol" should be -- Internet protocol --;

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kulakowski.

7. With respect to claim 16, Kulakowski teaches a method to support a fax over Internet protocol session (fig. 1), the method comprising:

connecting a client (14) to first Internet service provider (18) that does not need to include fax over Internet protocol functionality over a first connection, the client comprises a fax over Internet protocol client driver that is operable to support a fax over Internet protocol session (page 14, lines 26-36);

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establishing a second connection between the first Internet service provider and a second Internet service provider (32) via an Internet protocol network (fig. 1);

the second Internet service provider establishes a third connection with a fax machine (28);

transmitting a fax from the client to the fax machine using a fax over Internet protocol session that is supported by the fax over Internet protocol client driver of the client via the first connection, the second connection, and the third connection (page 14, lines 26-36).

8. With respect to claim 18, Kulakowski teaches the method of claim 16, wherein the client comprises at least one additional fax machine, the at least one additional fax machine comprises an Internet capable fax machine (14).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 11, 15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski.

9. With respect to claim 9, Kulakowski discloses a system for transmitting faxes, comprising:

a client (14) having a modem that is compatible with a fax over Internet protocol client driver (90 in fig. 6) that is supporting a fax over Internet protocol session (page 14, lines 26-36);

a first Internet service provider that is not a fax gateway (18), the client connects to the first Internet service provider using the modem and the fax over Internet protocol client driver (page 14, lines 26-36);

a second Internet service provider (32);

a fax machine communicatively coupled to the second Internet service provider (fig. 1); and

the client maintains a fax over Internet protocol session with the fax machine using the fax over Internet protocol client driver, and the client is not the first Internet service provider (fig. 1).

Although Kulakowski does not expressly disclose the client being a personal computer, Examiner takes an Official Notice that implementing the facsimile capability in the personal computer system is well known in the art.

Therefore, it would have been obvious to obtain the invention as specified in claim 9 in view of Kulakowski.

10. With respect to claim 11, Kulakowski discloses that the Internet protocol network comprises the Internet (20).

11. With respect to claim 15, Kulakowski discloses that the client connects to the first Internet service provider using a PSTN (page 8, lines 6-8).

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12. With respect to claim 21, Kulakowski discloses that the modem supports data communication over one or more of the group comprising a PSTN, a DSL connection, and an ISDN connection (page 8, lines 6-8).

Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joffe et al. U.S. Patent No. 6,801,341 (hereinafter Joffe) in view of Kulakowski.

13. With respect to claim 1, Joffe discloses a T38 driver system (fig. 2), comprising:

a client (FAX 32) for requesting fax over Internet protocol session;

a first Internet service provider (access server 40), the client connects to the first Internet service provider (fig. 2);

a second Internet service provider (access server 62) that is operable to support a T38 protocol (col. 5, lines 33-46 and col. 6, lines 27-30);

an Internet protocol network (IP network 46), the first Internet service provider and the second Internet service provider are communicatively coupled via the Internet protocol network (fig. 2);

a telephone network provider (PSTN 66);

a fax machine (FAX 70) that is operable to be communicatively coupled to the second Internet service provider via the telephone network provider;

a fax over Internet protocol session is maintained between the client and the fax machine via the first Internet service provider, the Internet protocol network, the second Internet service provider, and the telephone network provider (col. 4, lines 24-42);

the client maintains the fax over Internet protocol session with the fax machine using the T38 protocol client driver (col. 5, lines 33-46 & col. 6, lines 27-30).

Joffe, however, does not expressly teach that the T38 protocol driver, which is a fax over Internet protocol driver, is included in the client system.

Kulakowski, the same field of endeavor of Internet facsimile transmission, discloses a facsimile client driver system (fig. 1) comprising:

*a client (fax machine device 14 in fig. 1) having a fax over Internet protocol client driver (protocol module 90) that is operable to support a fax over Internet protocol session (page 14, lines 26-36);*

a first Internet service provider (18), the client connects to the first Internet service provider (fig. 1);

a second Internet service provider (32);

an Internet protocol network (20), the first Internet service provider and the second Internet service provider are communicatively coupled via the Internet protocol network (fig. 1);

a telephone network provider (page 8, lines 6-8);

a fax machine that is operable to be communicatively coupled to the second Internet service provider via the telephone network provider (page 8, lines 6-8);

a fax over Internet protocol session is maintained between the client and the fax machine via the first Internet service provider, the Internet protocol network, the second Internet service provider, and the telephone network provider (fig. 1); and



the client maintains the fax over Internet protocol session with the fax machine using the fax over Internet protocol client driver (page 14, lines 26-36).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to include the fax over Internet protocol driver inside the client system of Joffe.

The suggestion/motivation for doing so would have been to meet the requirements required by the Internet service provider (page 14, lines 26-36 of Kulakowski) from the client device.

Therefore, it would have been obvious to combine Joffe with Kulakowski to obtain the invention as specified in claim 1.

14. With respect to claim 2, Kulakowski discloses that the driver is contained in a memory (34 of figs. 2 & 6).

15. With respect to claim 7, the combination of Joffe and Kulakowski discloses the T38 client driver system of claim 1, wherein the client comprises a personal computer (PC12 in fig. 1 of Joffe). It, however, does not disclose expressly that the client comprises a laptop computer. Examiner takes Official Notice that using a laptop computer as a personal computer is well known in the art. The suggestion/motivation for using a laptop instead of a personal computer would have been to provide the user with a portable computer.

16. With respect to claim 8, Kulakowski discloses that the client comprise a modem having a firmware; and the driver is contained within the firmware (page 14, lines 26-36 and 34 of figs. 2 & 6).

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Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Joffe and Kulakowski as applied to claim 1 above, and further in view of Nagai et al. U.S. Patent No. 6,636,587 (hereinafter Nagai).

17. With respect to claim 3, the combination does not teach expressly that the Internet protocol network comprises a private network that is operable using an Internet protocol.

Nagai, the same field of endeavor of the Internet facsimile transmission, discloses that the Internet protocol network comprises a private network (Intranet or ITN) that is operable using an Internet protocol (figs. 1 & 2).

As well known in the art, it would have been obvious to one of ordinary skill in the art to implement the private network in the facsimile transmission network of Kulakowski.

The suggestion/motivation for doing so would have been to provide the facsimile communication system in the private network as well.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 3.

18. With respect to claim 6, the combination does not teach expressly that the client is operable to maintain at least one additional protocol session.

Nagai, the same field of endeavor of the Internet facsimile transmission, discloses that at least one additional Internet protocol session can be operated, such as a web browser, during the facsimile transmission. Further, at the time of invention, it is

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well known in the art that any PC connected to the Internet can perform various/simultaneous communications using IP session.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have at least one additional protocol session in the facsimile system.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Joffe and Kulakowski as applied to claim 1 above, and further in view of Shibata U.S. Patent No. 6,825,955.

19. With respect to claim 4, the combination of Joffe and Kulakowski discloses the T38 client driver system of claim 1, but it does not disclose expressly that the client connects to the first Internet service provider using an ISDN.

Shibata, the same field of endeavor of the Internet facsimile transmission, discloses Internet facsimile for transmitting facsimile data to the destination facsimile via the Internet wherein the transmitting Internet facsimile connects to the first Internet service provider (Internet service provider) using an ISDN (col. 6, lines 44-51).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the facsimile transmission using the ISDN of Shibata with the Internet facsimile system of the combination of Joffe and Kulakowski.

The suggestion/motivation for doing so would have been to provide a facsimile transmission system in the ISDN.

Therefore, it would have been obvious to combine the three references to obtain the invention specified in claim 4.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Joffe and Toyoda as applied to claim 1 above, and further in view of Rabenko et al. U.S. Patent No. 6,765,931 (hereinafter Rabenko).

20. With respect to claim 5, the combination of Joffe and Kulakowski discloses the T38 client driver system of claim 1, but it does not disclose expressly that the client connects to the first Internet service provider using an ADSL.

Rabenko, the same field of endeavor of the Internet facsimile transmission, discloses a facsimile that communicates via an ADSL (col. 9, lines 1-4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the facsimile transmission using the ADSL of Rabenko with the Internet facsimile system of the combination of Joffe and Kulakowski.

The suggestion/motivation for doing so would have been to provide a facsimile transmission system in the ADSL.

Therefore, it would have been obvious to combine the three references to obtain the invention specified in claim 5.

Claims 10 and 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Kulakowski as applied to claim 9 above, and further in view of Nagai.

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21. With respect to claim 10, arguments analogous to those presented for claim 6, are applicable.

22. With respect to claim 12, arguments analogous to those presented for claim 3, are applicable.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Kulakowski as applied to claim 9 above, and further in view of Joffe.

23. With respect to claim 14, as set forth above in the rejection of claim 1, one of ordinary skill in the art would have been motivated to combine Kulakowski with Joffe to provide a fax over Internet protocol drive, which includes the T38 protocol, in the client system. Thus, it would have been obvious to obtain the invention as specified in claim 14.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Kulakowski as applied to claim 16 above, and further in view of Rabenko.

24. With respect to claim 17, arguments analogous to those presented for claim 5, are applicable.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Kulakowski as applied to claim 16 above, and further in view of Nagai.

25. With respect to claim 19, arguments analogous to those presented for claim 3, are applicable.

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26. With respect to claim 20, arguments analogous to those presented for claim 6, are applicable.

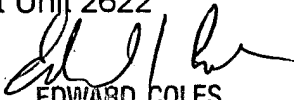
**Conclusion**

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
September 16, 2005

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